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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,211	01/22/2004	Ramon C.W. Chea JR.	085638/0307700	8070
27498	7590	07/28/2004	EXAMINER	
PILLSBURY WINTHROP LLP			BENENSON, BORIS	
2475 HANOVER STREET			ART UNIT	
PALO ALTO, CA 94304-1114			PAPER NUMBER	
			2836	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/764,211	Applicant(s) CHEA, RAMON C.W.	
	Examiner Boris Benenson	Art Unit 2836	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/19/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-8 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6700770. Although the conflicting

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claims are not identical, they are not patentably distinct from each other because omitted from independent Claim 1 of this application is the limitation requiring a current detector and comparator. This obviously must be present for "detecting a current in the copper loop" and for "comparing the sensed current with a threshold current associated with a device", as required by the claim.

2. Claims 9-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-21 of U.S. Patent No. 6700770.

Although the conflicting claims are not identical, they are not patentably distinct from each other because it is obvious to one of ordinary skill in the art that a TRIAC in a voltage suppressor required by Claims 9 and 15 of U.S. 6700770 may be easily substituted with any type silicon controlled rectifiers or a zener diode coupled to a pair of transistors.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-2 and 4-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maytum et al. appl. (2002/0075623), filed on 12.18.2001 in view of Applicant Admitted Prior Art.

Referring to Claims 1, 7, 9 and 14, Maytum et al. disclose a modem protection circuit where a sensor (Fig.2, Pos. R) detects a current in a line (11) and if such current exceeds predetermine level turn on a voltage suppressor (116a), limiting an electrical power fault voltage that is exposed to a device. It would have been obvious to one of ordinary skill in the art at the time the invention that in order to protect a device in a double end exposed system a protection circuitry should be installed on both sides of the device and will require simply duplication of parts used for providing protection of the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make such duplication, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8.

Referring to Claims 2, 8, 10 and 15-17 a method disclosed by Maytum et al. includes a current sensor comprising a resistor

(R), coupled to the subscriber line and a value of the resistor defines a threshold for turning the voltage suppressor on.

Referring to Claims 4-6 and 19, a method disclosed by Maytum et al. protects a modem that can be described as a micro electrical system. The method includes protection over lightning exposure and an electrical power surge using an overvoltage protector in combination with over current protection and as over current protector a fuse (14).

Referring to Claims 7 and 13, a current sensor is detecting an overcurrent and triggers the overvoltage suppressor. The overvoltage suppressor comprises a TRIAC (116) and protects the device against voltage pulses.

Referring to Claim 15, a means for detecting current comprises a sensing resistor on the subscriber loop coupled to control input read on current detector of the voltage suppressor. A value of the resistor defines a threshold for turning the voltage suppressor on.

Referring to Claims 11 and 12, Applicant admits, "described components with reference to FIGS. 8, 9A and 9B are well known in the art" (Page 18 lines 5-6).

***Allowable Subject Matter***

3. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent

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form including all of the limitations of the base claim and any intervening claims and if a double patenting rejection is overcome.

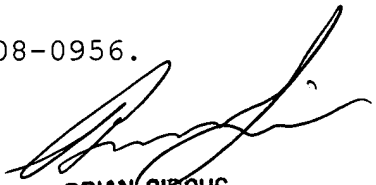
Claims is allowable because none of the prior art of record disclose the over current protector comprising a comparator and an amplifier in combination with the other claim limitations.

### **Contact information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris Benenson whose telephone number is (571) 272-2048. The examiner can normally be reached on M-F (8:20-6:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Sircus can be reached on (571) 272-2800 x 36. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



**BRIAN SIRCUS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2800**